

REMARKS

Status of the claims

In his March 24, 2004, Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. § 101 as inoperative and non-utilitarian. The Examiner also rejected claims 1-20 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,956,737 to King in view of U.S. Patent No. 6,535,294 to Arledge et al.

Applicant has amended claims 1, 3-11, 13, 16, and 21. The amendments do not add new matter. Page 8, lines 3-10 describe various internet-accessible interfaces. Page 10, lines 18-24 describe user-indicative and company-indicative information. The description of the purchasing interface on page 14, lines 16-24 provides written description support for the newly added "profile management interface" limitation cited in claim 1. The description of the purchasing and processor interfaces on pages 15 and 16 provide written description support for what is now described as the "order processing interface" of claim 1 and its dependent claims. Page 10, lines 2-4 and page 11, lines 4-7 support the limitation added to claim 1 that "the requestor interface does not enable the user to modify the typography of any information to be printed on the business card or stationery product." Page 12, lines 12-14 provide written description support for the limitation, added to claim 3, that "the requestor interface enables a user to select only those products for which prototypical product records have been developed." Fig. 6, page 12, lines 10-14, page 13, lines 11-13, page 14, lines 9-15 and 21-22, and page 15, lines 4-6 provide support for limitations in claims 5 and 6 restricting a user's ability to modify company-indicative information or select titles through the user requestor interface. The amendment to claim 21 was made for clarification only (not for patentability and not to surrender any scope in order to overcome the rejection).

Section 101 rejection

Applicant respectfully requests reconsideration of the section 101 rejection of claims 1-24. The Examiner argued that because the claims fail to mention programs and executable code embedded in a computer-readable medium, the systems claimed are incapable of work since there are no processors to run any program.

But "the claims need not recite every component necessary to enable operation of a working device." *Rambus Inc. v. Infineon Techs. Ag*, 318 F.3d 1081, 1093 (Fed. Cir. 2003) (citing *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999) (applicant need not claim every feature of a working device)); see also *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269 (Fed. Cir., 1986) ("CBS also argues that the subject matter of the claims are not 'useful' because the claims do not 'teach' anyone the complicated method of solving Nichols' or Rubik's puzzle. The argument misperceives the purpose of a claim."); *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1181 (Fed. Cir. 1991) ("'[I]t is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter,' as it is 'entirely appropriate, and consistent with § 112, to present claims to only [one] aspect.'") (quoting *Bendix Corp. v. United States*, 600 F.2d 1364, 1369 (Ct. Cl. 1979).

“To violate § 101 the claimed device must be totally incapable of achieving a useful result.” *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992). Therefore, “[t]he inoperability standard for utility applies primarily to claims with impossible limitations.” *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1339 (Fed. Cir. 2003). And generally, rejections for non-utility are based on evidence or some well-established physical or mathematical principle. For example, in *In re Swartz*, 232 F.3d 862, 864 (Fed. Cir. 2000), the patent examiner rejected claims to cold fusion under section 101 based on several references showing that results in the area of cold fusion were irreproducible. The Federal Circuit affirmed the rejection. *See also Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1359 (Fed. Cir. 1999) (holding that claim that embodied “an inoperable method that violates the principle of conservation of mass” was inoperative).

Claims 1-24 do not suffer any such defect. The limitations are not “impossible.” Moreover, the specification adequately enables the claimed invention by disclosing computers and processors for implementing the disclosed automated print order system.

Section 103 rejections

Applicant also asks that the Examiner reconsider the rejections of claims 1-24 in light of the amendments made thereto.

Applicant is well aware that a section 103(a) rejection based on a combination of references cannot be overcome merely by attacking the individual references. But examination of what each of the references teach individually is an important step in understanding whether a person of ordinary skill in the art would be motivated to combine the references in a manner that reads on the invention as claimed.

- **U.S. Patent No. 5,956,737 to King**

The King reference, for a “design engine for fitting content to a medium,” is directed to the problem of transforming and repurposing pre-existing layout and format information for one media for reuse in another media. King’s disclosure is not concerned with “automated print order systems,” nor does it suggest application to that field.

To the Examiner’s credit, King does teach a logical three-way separation between content, design and media. And King does teach a system that intelligently reformats layout and text size information specified for one media for use in a different media, as illustrated in the transformation of FIGS. 9 into FIGS. 11 or FIGS. 12a, 12b, and 12c. *See* col. 18, lines 57-64 (“FIGS. 12a, 12b and 12c illustrate at 190 the brochure composition of FIG. 9 that has been rendered to HTML media. In this example, the single page paper media layout of Fig. 9 has been automatically transformed into a three-page HTML layout suitable for presentation on the World Wide Web, for example.”). King even teaches a “blank composition” (FIG. 8) that contains formatting and layout structure information, into which the user may “drag and drop content.” Col. 18, lines 1-42.

But King does not separate the editorial functions of defining and selecting the formatting and content of the media as claimed in the claimed invention. King states that “the user may rearrange the design shown in order to create a custom design,” col. 18, lines 13-14, thereby overriding the formatting and layout structure of the “blank composition.” King’s user interface also permits the user, without restriction, to “perform editing of the content directly in the composition through the user interface.” *See also* Figs. 1, 1A, 1B, 1C, 1D, 2; col. 7, lines 15-27 (“In this example, the user has added a new content element 22 that now appears on the user interface 18’ to the right of the content element 20’. The user has also specified a new design description for the content elements. . . . Generally, a user may change one or all of the content, design and media aspects of the composition and have the composition be automatically adjusted by the application program 12.”).

This is in contrast to claim 1, which as amended recites that “the requestor interface does not enable the user to modify the typography of any information to be printed on the business card or stationery product.” This is also in contrast to claim 21, which as amended recites that the requestor interface “does not enable the user to independently define or modify the organization-identifying informational content to be printed on the stationery product.”¹ This is also in contrast to dependent claim 5, which recites that the “requestor interface does not enable the user to modify at least a portion of the company-indicative information of said selected predeterminable profile.”

The cited limitations are in keeping with the stated object of the invention of “providing consistently accurate, fully company tailored business card and stationery products” (see specification, pages 3-4) to different users within that company.

King also provides no disclosure or suggestion of distinct profile-management and requestor interfaces (claim 1), or of predeterminable profiles that contain both user-indicative and company-indicative information (claim 1), or that the user-indicative information includes the name and title (claim 4), or that the user’s title is a pre-authorized title selected from a drop-down menu (claim 6).

As explained below, the combination of King with Arledge does not supply any of the aforementioned missing elements or limitations.

- **U.S. Patent No. 6,535,294 to Arledge**

The Arledge reference, for a “System and Method for Preparing Customized Printed Products over a Communications Network,” is directed to a user-specific system and method of preparing customized printed products. While Arledge, unlike King, is concerned with

¹ King’s user interface also did not “deny the user any ability to define or modify one or more of the common informational elements of the customized templates,” as previously recited in claim 21. This is noted because the clarifying amendment to this limitation was not made to *further* distinguish the claim (and thus create a presumption of no doctrine of equivalents coverage).

“automated print order systems” that enable users to create, order, re-order, and even modify customized print products over the Internet, Arledge *is not* concerned with designing *company-tailored* customized printed products providing different levels of editorial or customization-type control to different levels of personnel.² Therefore, Arledge fails to describe a user interface and information processing architecture for an automated print system that would meet the object of “providing consistently accurate, fully company tailored business card and stationery products” (see specification, pages 3-4) to different users within that company.

Arledge discloses a series of interface screens to enable the same user to create, order, re-order, and modify customized print products over the Internet. Figs. 4-7 and 16 depict the log-on and create-a-user-account (or user registration profile) screens. Col. 11, line 66 – col. 14, line 44. Figs 8-11 and 17 depict screens associated with selecting a product to order and optionally customize and prepare. Col. 14, line 45 – col. 16, line 43; col. 18, lines 7-29. Arledge states that the types of products (labels, business cards, stationery, and the like) that the retailer provides to the user is “predefined by the retailer in establishing the retailer’s dealer account.” Col. 14, line 64 – col. 15, line 12. Arledge does not, however, suggest that the range of available products presented on the Fig. 8 screen are *further* predefined or customized for specific corporate customers.

Figs. 9 and 10 depict the interfaces Arledge provides to enable the user to *customize* a selected print product. In Fig. 9, the user can upload artwork, such as a company logo, into an artwork database that “is then associated with the end-user’s registered account and usable by the end-user for the present, as well as for future, orders.” Col. 15, lines 33-43. In Fig. 10, Arledge provides a “*layout tool* applet window 330 [that] includes a customized product image template 331, initially having a blank image with chosen specifications, such as product size and shape, of the selected product” Col. 15, lines 55-58. This *layout tool* applet window 330 enables the user to define *both* the formatting *and* the textual and graphical content of the to-be-printed product:

For example, in response to selecting the “Add Text” action button 332a, the second layout tool field 333 may include a first popup list having a predefined list of selectable fonts thereon, a second popup list having a predefined list of selectable font sizes thereof, and a data-entry field into which the end-user would enter the text to be added to the image template 331. . . . (Col. 16, lines 2-7)

. . . . The end-user uses the layout tool fields 332, 333, 334 to add, delete and position text, images, graphics and artwork to the image template 331 until a desired layout is completed. (Col. 16, lines 16-18).

² See specification, page 9, lines 22-23 (discussing different levels of control). The distinct profile management and requestor interfaces provided in claim 1 facilitate different levels of control. The separation in claims 1 and 12 of the functions of customizing the predeterminable product records and the definition or selection of predeterminable profiles to provide the content for the printed product further facilitate different levels of control.

In short, Arledge does not separate editorial control over the format and content of the printed products in the manner claimed by claims 1 and 21.

Arledge states that its system permits the end-user to reorder previously-prepared printed products by selecting hypertext button 373 on the interface shown in Fig. 18. Col. 18, lines 42-46. In response to that selection, the user is presented with a list identifying previously submitted order. *See* Fig. 19. "The end-user may select an individual previous order from the list 386 to re-order the same, either with or without further customization, *as herein described.*" Col. 19, lines 11-13. In other words, not even the re-order function separates editorial control over the format and content of the printed products in the manner claimed by claims 1 and 21.

Arledge also *teaches away* from providing consistently accurate, fully company tailored business card and stationery products to different users within that company. Arledge provides that "[e]nd-user defaults, including previously prepared customized printed products, are preferable [sic] not transferable from one end-user to another, thereby promoting end-user-retailer loyalty." Col. 14, lines 41-44.

Arledge's discussion of the prior art also fails to fill in the gaps. Arledge notes that the product "VIRTUAL PRE-PRESS permits an end-user thereof to connect via the Internet to the Digital-Net VIRTUAL PRE-PRESS order processing system through a hypertext link from a subscribing third-party print shop web site, prepare a customized printed product, such as a business card, using the VIRTUAL PRE-PRESS system, and submit a formatted, digital file copy of the customized printed product attached to an e-mail sent from the VIRTUAL PRE-PRESS system to the third party print shop over the Internet." Col. 2, lines 11-19. This description suggests that the same user also specifies both the content and the formatting of the content.

In sum, both King and Arledge, individually and in combination, fail to meet the following limitations of the claims. Neither provides any disclosure or suggestion of an automated print order system developed around a set of company-tailored prototypical product records and a set of selectable predeterminable profiles with an internet-accessible requestor interface with restricted editorial functions that enables a user to select a "predetermined profile" to define the content of a company-tailored business card or stationery product that is to be formatted according to a company-tailored prototypical product record (the prototypical product record being distinct from the predeterminable profile) (claim 1; claim 21 similar). Neither provides any disclosure or suggestion of having these selectable "predeterminable profiles" contain both user-indicative and company-indicative information (claim 1) or common and specific informational elements (claim 21), much less that that the user-indicative information includes the user's name and title (claim 4), or that the user's title is a pre-authorized title selected from a drop-down menu (claim 6). Neither King nor Arledge provides any disclosure or suggestion of an internet-accessible requestor interface that "denies the user any ability to define or modify one or more of the common informational elements of the customized templates" (claim 21; *cf.* claim 5).

Applicant also does not believe that either King or Arledge suggests a combination or modification of either or both references to cover the invention as claimed. Starting from King, no motivation or suggestion is expressed to adapt King to an automated print-ordering system having company-tailored prototypical product records or templates associated with available printed products and an internet-accessible requestor interface that requires the user to select one of these template-associated print products, enables the user to select a profile to supply the content for the template, and restricts the user's editorial control over the content or formatting of the data. There are simply too many modifications involved. To say that all of them are obvious is to rely on hindsight. If a person of ordinary skill in the art started instead from Arledge, which is directed to an automated print-ordering system, Arledge expresses no suggestion or motivation at all for repurposing a user-customized printed product to another print media (which would suggest combination with King). But even if Arledge were modified to incorporate the architecture and methodology of King, it would still fail to cover all of the limitations or elements of claims. And there is no known teaching or suggestion in the prior art to further modify an Arledge-King combination to meet those limitations or elements.

Applicant respectfully requests withdrawal of the rejections and allowance of the claims in light of these arguments and the amendments made to the claims.

Official Notice

With respect to the issues of "Official Notice" raised in the Examiner's Office Action, and the provision in MPEP 2144.03 that provides that "If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art," Applicant notes that:

- Patent prosecution has not traditionally been conducted as a formalistic enterprise involving strict pleading requirements and "gotcha" you-forever-waived-that-argument traps. The PTO and the courts do rightly expect patent practitioners to seasonably make arguments and amendments to advance the prosecution. The Applicant has in good faith attempted to do that.
- The MPEP does not have the force of law. *See Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10, 33 U.S.P.Q.2D (BNA) 1823, 1828 n.10 (Fed. Cir. 1995). The Foreword to the Manual states that it "does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations."
- The case relied upon for the MPEP's proposition, *In re Chevenard*, 139 F.2d 711 (C.C.P.A. 1943), does not support the proposition that any dispute is waived if not immediately and completely set forth in the first response to the office action. Rather, *Chevenard* holds if the applicant *never* contradicts or makes a demand in the prosecution history record, the appellate court will not consider it. It says nothing about seasonableness.³

³ The relevant text is as follows:

- The one case cited by *In re Chevanard* and the only two cases that cite *In re Chevanard* also do not support the proposition that any dispute is waived if not immediately and completely set forth in the first response to the office action.⁴
- “[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work” and “allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported.” *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).
- Noticed facts serve to “fill the gaps” and should not comprise the principle evidence on which a rejection is based:

[T]he Patent Office appellate tribunals, where it is found necessary, may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute. *In re Knapp Monarch Co.*, 296 F.2d 230 (C.C.P.A. 1961). This rule is not, however, as broad as it first might appear, and *this court will always construe it narrowly* and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. . . .

We know of no case in which facts judicially noticed comprised the principal evidence upon which a rejection was based or were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used.

In re Ahlert, 57 C.C.P.A. 1023, 1027-28 (CCPA 1970).

The four single-spaced, reduced-font pages of “officially noticed” prior art goes beyond filling the gaps. Some of it is well-taken. But applicant believes that some of the assertions, particularly many of the assertions about the motivation of those of ordinary skill in the art to carry out the invention exactly as claimed, are hindsight-based. Applicant need not produce copious amounts of evidence to overcome, point by point, each of the disputed particular statements, particularly when, as here, the Applicant’s amendments or new cited references have made many of those statements moot. Applicant has in good faith attempted to fully and completely respond to the Examiner’s cogent arguments with amendments (many of which have narrowed the scope of the claims) and good-faith arguments.

The appellant in his brief states that the examiner cited nothing to support his holding with respect to the brief heating at 550 [degrees] to 750 [degrees] C., as the equivalent of a longer heating at a lower temperature, and insists that the examiner's assertions do not coincide with the actual facts. In the absence of anything in the record to contradict the examiner's holding, and in the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.

⁴ See *In re Gunther*, 29 C.C.P.A. 888, 893 (CCPA 1942); *In re Soli*, 50 C.C.P.A. 1288, 1293 (CCPA 1963); and *Ex Parte Mattel Inc.*, Appeal No. 2003-0162, at <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd030162.pdf>.

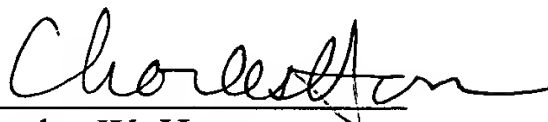
Appl. No. 09/487,387
Amdt. dated July 22, 2004
Reply to Office Action of March 24, 2004.

CONCLUSION

Having addressed all matters raised by the Examiner's March 24, 2004, Office Action, Applicants respectfully request that the claims be allowed.

Respectfully submitted,

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